

**REMARKS**

The above-identified application was allowed in the Notice of Allowability mailed April 8, 2008. The Notice of Allowability included an objection to the drawings under 37 C.F.R. § 1.83(a) and an associated requirement for corrected drawings to be submitted that include a reference number in the drawings to illustrate the toroidal surface feature.

This requirement was discussed, previous to issuance of the Notice of Allowability, between United States Patent and Trademark Office Examiner James R. Greece and Applicants' undersigned representative in a telephone interview conducted on March 31, 2008. During that interview, the Examiner had noted that upon review of this case, the Examiner's supervisor had requested that at least one drawing figure of this application be amended to include a reference numeral to refer to the toroidal surface feature of the claims. This request resulted in the above-discussed objection to the drawings that was included in the Notice of Allowability.

Upon a detailed study of this requirement for corrected drawings, Applicants came to a conclusion that reference numeral "3" in the drawings of this application already refers to this toroidal surface feature. Accordingly, Applicants' undersigned representative conducted a further telephone interview with Examiner Greece on May 21, 2008 in this regard and the Examiner noted that an interview should be scheduled to discuss this issue together with the Examiner's supervisor. The Examiner also noted that Applicants' undersigned representative should send a detailed agenda of the points to be discussed during the interview.

Accordingly, on May 23, 2008, Applicants' undersigned representative forwarded a facsimile communication to Examiner Greece formally requesting an interview on either May 29

or 30, 2008. The facsimile communication also included the following technical remarks as to why the toroidal surface is already indicated by reference number “3” in this application.

The technical remarks stated that, with regard to Figs. 1A and 1B of the instant application, a description is provided at paragraphs [0045] and [0046] of the specification that “[a]s shown in Fig. 1A and Fig. 1B, the solid immersion lens 1 according to the present embodiment comprises a spherical portion 2 and a bottom surface portion 3,” and “the bottom surface portion 3 has a cylindrical shape.”

The technical remarks went on to point out, however, that paragraph [0016] explains that “[i]n the solid immersion lens according to the present invention, the attaching surface to an observed object is formed in a toroidal shape. Concretely, the bottom surface of the solid immersion lens is an aspherical surface (toroidal surface) ...” Paragraph [0016] goes on to explain that “in the present invention, a curved surface whose base axis to form a shape appropriate for optical coupling is a straight line and whose other axis is an arc, namely, a cylindrical shape (cylindrical surface) is also included in the toroidal shape (toroidal surface) (emphasis added).”

Further along these lines, the technical remarks explained that in paragraph [0091] a description is provided that “the solid immersion lens according to the present invention is not limited to a solid immersion lens whose bottom surface has a cylindrical shape, and it can employ a mode wherein the bottom surface has been formed in another toroidal shape (emphasis added).”

Applicants undersigned representative had received a telephone call from USPTO Examiner James Greece on March 28, 2008 in which the Examiner expressed his initial

understanding that dependent claim 3 of the instant application appeared to be inconsistent with claim 1 because claim 1 describes that an attaching surface is of a toroidal shape and dependent claim 3 describes that the same attaching surface is of a cylindrical shape. However, Applicants undersigned representative received a further telephone call from USPTO Examiner James Greece later in the same day on March 28, 2008 in which the Examiner explained that upon further study of the disclosure of the instant application, the Examiner had now realized and concluded that claims 1 and 3 are already consistent with each other in their current form, as filed on January 3, 2008 and no claim amendments were thus necessary.

The technical remarks went on to note that the Examiner's conclusions in this regard are consistent with the above-described explanation of why Applicants understand, from at least these descriptions in the specification of the instant application, that reference numeral "3" in Figs. 1A and 1B denotes the bottom surface having the cylindrical shape, and at the same time, this reference numeral "3" also clearly denotes the bottom surface having the toroidal shape.

For at least these technical reasons, withdrawal of the requirement for corrected drawing sheets in the Notice of Allowance dated April 8, 2008 was respectfully requested in the facsimile communication dated May 23, 2008.

After considering these technical remarks with his supervisor, Examiner Greece and Applicants' undersigned representative conducted a follow-up telephone interview on May 28, 2008. During that follow-up telephone interview, Examiner Greece and Applicants' undersigned representative reached agreement that the outstanding drawing objection and associated requirement for corrected drawings could be overcome by implementing a minor revision to

paragraph [0091] of the specification in the manner implemented in the instant Amendment after Allowance.

Accordingly, Applicants respectfully request that the above-discussed amendment to paragraph [0091] of the specification, as submitted in the instant Amendment after Allowance under 37 C.F.R. § 1.312, be approved and entered by the Examiner in this application.

Paragraph [0091] is newly-amended in the instant Amendment after Allowance under 37 C.F.R. § 1.312 in order to further improve the form of the specification as agreed to with United States Patent and Trademark Office Examiner James R. Greece in the telephone interview conducted on May 28, 2008 between the Examiner and Applicants' undersigned representative. The amendment to the specification is not being made for any reason relating to compliance with any of the statutory requirements for patentability or for any reasons relating to patentability in view of prior art.

The amendment to the specification in the instant paper is fully supported by the specification and drawings, will not require an additional search, and does not raise new issues. Therefore, Applicants respectfully request that this amendment to the specification be entered and the requested changes made.

Examiner Greece indicated during the May 28, 2008 telephone interview that he would approve this amendment to paragraph [0091] of the specification once it was filed in an Amendment after Allowance under 37 C.F.R. § 1.312.

As also discussed with Examiner Greece on May 28, 2008, Applicants note further that the disclosure of the present application teaches that a cylindrical shape is one type of toroidal

shape. See, for example, paragraphs [0018] – [0020] of the specification of the instant application.

Accordingly, for at least the foregoing reasons, the Examiner's approval and entry of this amendment to paragraph [0091] of the specification of the instant application is respectfully requested. Also, withdrawal of the outstanding drawing objection and associated requirement for corrected drawings in the Notice of Allowance dated April 8, 2008 is also respectfully requested.

### **CONCLUSION**

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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